

RECEIVED
CENTRAL FAX CENTER

FEB 14 2008

KRIEG · DEVAULT LLP
ATTORNEYS AT LAW**FAX COVER PAGE**

DATE: February 14, 2008

PAGES INCLUDING THIS PAGE: 12

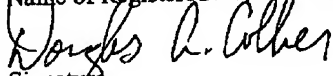
TO: Examiner Anuradha Ramana, Group Art Unit 3733
COMPANY: U.S. Patent and Trademark OfficeFAX NUMBER: 571-273-8300
PHONE NUMBER:

FROM: Douglas A. Collier

DIRECT DIAL: (317) 238-6333
FAX NUMBER: (317) 636-1507

RE: Notice of Appeal for U.S. Patent Application No. 10/633,288 to Charles L. Branch et al.

COMMENTS: I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at 571-273-8300 on:

February 14, 2008
(Date of Transmission)Douglas A. Collier
Name of Registered Representative
SignatureHard copy will be sent via: ☐ Regular Mail☐ Overnight Courier☒ Fax Communication Only

Name of Sender: Cheryl Kalugyer

Client Matter No.: 333 MSDI-261

WARNING CONFIDENTIALITY NOTICE

The documents constituting this fax transmittal contain confidential information belonging to the sender which is legally privileged. The information is intended only for the use of the individual(s) or entity named above. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance upon the content of this fax transmittal is strictly prohibited. If you have received this fax transmittal in error, please immediately notify us by telephone at the number below to arrange for return of the original documents to us. Thank you.

For Questions or Problems in Transmission, Please Contact our Fax Operators

KRIEG DEVAULT LLP
ONE INDIANA SQUARE
SUITE 2800
INDIANAPOLIS, IN 46204
TELEPHONE-(317) 636-4341
FAX-(317) 636-1507KRIEG DEVAULT LLP
12800 N MERIDIAN STREET
SUITE 300
CARMEL, IN 46032
TELEPHONE-(317) 566-1110
FAX-(317) 636-1507KRIEG DEVAULT GALVIN
LLP
5231 HOHMAN STREET
HAMMOND, IN 46320
TELEPHONE-(219) 933-0380
FAX-(219) 933-0471KRIEG DEVAULT LUNDY
LLP
825 ANTHONY WAYNE
BUILDING
203 EAST BERRY STREET
FT. WAYNE, IN 46802
TELEPHONE-(260) 422-1534
FAX-(260) 423-1590

KD_IM-1277117_1.DOC

along a surface of accessory device 2860 while maintaining frictional engagement with the wall surface of accessory device 2860 as recited in claims 26 and 36.

Base claim 46 also stands rejected as anticipated by Parker et al. Parker et al. disclose a light transmitting member 2810 with a circular cross-section, which, as best seen in FIG. 28B, includes a convexly curved outer surface 2802 which extends about member 2810 and is exposed to the working channel provided by accessory device 2860. However, concavely curved inner surface 2804 is not exposed to the working channel. Additionally, the embodiment of Figures 25A and 25B fails to disclose a concavely curved inner wall surface of the lighting element or any concavely curved inner wall surface of the lighting element oriented toward and exposed to the working channel of the retractor as recited in claim 46.

Further reasons support patentability of rejected dependent claims. Claims 6, 19, 29 and 39 recite "wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting element extends about at least 50 percent of said inner wall surface." Parker et al. do not disclose a retractor with an inner wall surface to which the lighting element is engaged that substantially encloses the working channel.

Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." These claims are not anticipated for the reasons provide above with respect to claims 26 and 36.

Claims 1-2, 4-8, 16-21, 26-27, 29, 31, 36-37, 39-40, and 46 stand rejected as anticipated by U.S. Patent No. 3,796,214 to Davis. This rejection is addressed on pages 5-7 of the Dec. 13 response and pages 6-11 of the Aug. 1 response. The examiner maintains that claims 1 and 16 only require the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. It is respectfully submitted that the rejection ignores the recitation in claims 1 and 16 that defines the frictional engagement to be sufficient to maintain a position of the lighting element relative to the retractor as set forth in claims 1 and 16.

Davis merely discloses that a fiber optic bundle is carried in each of the tubular members. There is no disclosure of how the fibers in the bundle are arranged, or that a fiber in the bundle

Page 3 of 5

Response to Final Office Action
Application No. 10/633,288
Docket No. MSDI-261/PC750.00

could be positioned against an inner surface of tubular member 50, 51 in frictional engagement therewith in a manner that is sufficient to maintain a position of another of the fibers in the bundle relative to the tubular member.

With regard to claims 26 and 36, the examiner asserts that the fiber optic bundle is axially and circumferentially movable along the inner wall surfaces of members 50, 51. A review of Davis did not reveal any disclosure of these features. Davis appears to disclose the fiber optic bundle is fixed in members 50, 51 since each member 50, 51 includes a coupler 55 for operatively connecting the fiber optic bundle to a light conducting tube 56. If the fiber optic bundle were moved axially or circumferentially in members 50, 51, it is not clear how the fiber optic bundle could be operatively coupled to light conducting tube 56 since they would no longer be aligned at the end of members 50, 51 for such a connection. Furthermore, members 50, 51 are fixed to retractor 12. See col. 3, lines 32-35.

With respect to claim 46, the examiner asserts Davis discloses a coupler 55 including a pair of wall members or parts that are oriented toward the working channel of the retractor. The rejection fails to address several limitations in the claim, including "a lighting element including a pair of wall members and at least one light transmitting element between said pair of wall members, said pair of wall members forming a concavely curved inner wall surface of said lighting element and an opposite convexly curved outer wall surface of said lighting element, said outer wall surface positionable along said inner wall surface of said retractor with said inner wall surface of said lighting element oriented toward and exposed to said working channel." Since coupler 55 completely lacks any inner wall surface oriented toward and exposed to a working channel of the retractor, it cannot anticipate claim 46.

In addition to the patentability of the corresponding base claims, further reasons support patentability of rejected dependent claims. For example, claims 3, 18, 28, 38 all recite the same features, yet, claims 3, 28 and 38 were not rejected by Davis. It is not understood how Davis could be properly considered to disclose these same features recited in claim 18.

Claims 6, 19, 29 and 39 recite "wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting element extends about at least 50 percent of said inner wall surface." Retractor 12 in Davis does not include any such inner wall surface, nor do the fibers in tubes 50/51 extend about at least 50

Page 4 of 5

Response to Final Office Action
Application No. 10/633,288
Docket No. MSDI-261/PC750.00

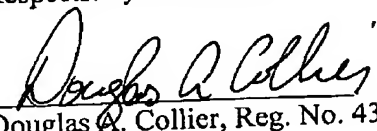
percent of any such surface of retractor 12. Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." These claims distinguish Davis for the same reasons discussed above with respect to claims 26 and 36.

Claims 9-14, 22-24, 32-34, and 42-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker et al. alone. This rejection was addressed on pages 7-8 of the Dec. 13 response and pages 16-17 of the Aug. 1 response. The examiner asserts "Parker et al. clearly discloses that the lighting device can have a cross-sectional area of any shape. It is also noted that a person of ordinary skill in the art has good reason to choose from a finite number of available shapes, i.e. known options within his or her technical grasp, for providing a cover to a lighting element." The examiner has not identified any teaching of the elements recited in these claims in the prior art, and has not provided any rational reason why one of ordinary skill in the art would modify Parker et al. to arrive at claims 9-14, 22-24, 32-34 and 42-44. Furthermore, even if there is a finite number of shapes from which to choose, the examiner has not identified any prior art teaching of the arrangement in claims 9-14, 22-24, 32-34 and 42-44. It appears that the only teaching to modify Parker et al. is in applicant's own specification, which is not prior art.

It is respectfully submitted that a prima facie case for finally rejecting claims 1-29, 31-40, 42-49 and 55-59 has not been established. Withdrawal of the final rejection is respectfully requested.

Respectfully submitted:

By:


Douglas A. Collier, Reg. No. 43,556
Krieg DeVault LLP
2800 One Indiana Square
Indianapolis, Indiana 46204-2079
Phone: (317) 238-6333

Response to Final Office Action
Application No. 10/633,288
Docket No. MSDI-261/PC750.00

Page 5 of 5